

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-22 are pending in the application, with claims 1, 18 and 22 being the independent claims. No claims are sought to be cancelled. New claim 22 is sought to be added. No claims are amended herein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Telephonic Interview with the Examiner on March 14, 2006

On March 14, 2006, Applicant's representative contacted Examiner Stashick regarding the rejections made in the November 15, 2005 Office Action. After discussing the nature of the invention, which a particular emphasis on paragraph [0028] of the specification, Examiner Stashick indicated that he did not fully appreciate that the protrusions do not extend into the receptacle but rather deflect or bow into the receptacle as a product of the diameter of the receptacle not be greater than the diameter of the protrusion. The Examiner indicated that he would have to reconsider the rejection based on the Lin reference in light of his new understanding of the invention. Applicant's representative pointed out that Lin appears to disclose supporting elements 34 that (either alone or collectively) fully occupy receptacle 28 formed by peripheral member 22. See Fig. 1 and col. 3, lines 12-20 of Lin. As such, receptacle 28 is greater in diameter than the supporting elements 34.

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The Brue' reference was also discussed. However, the Examiner indicated that he would prefer to review comments based on the Brue' reference in writing in order to fully appreciate the Applicant's position.

Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 1-2, 7 and 12-13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,733,483 to Lin. Independent claim 1 calls for "a sole for a shoe comprising: a midsole having at least one protrusion disposed in a forefoot region thereof; and a plate having at least one receptacle disposed therein, said plate placed adjacent to said midsole such that said receptacle aligns with said protrusion, *wherein a diameter of said receptacle is not greater than a diameter of said protrusion.*"

In the action, the Examiner argues that Lin discloses "at least one protrusion 34 disposed in a forefoot region" and "a plate 18 having at least one receptacle 28 disposed therein." (Office Action at 2.) However, as discussed with Examiner Stashick, central receptacle 28 is large enough to receive *all* of the supporting elements 34 of insert 10. Lin discloses a central receptacle 28 as the recess defined by a peripheral midsole member 22 that is dimensioned to receive the insert 10. See col. 2, lines 56-66. Thus, unlike the claimed invention, a diameter of the receptacle 28 - if there is a measurable diameter - is *much greater* than the diameter of any or all of the supporting elements 34.

Claims 2, 7 and 12-13 depend from and add further features to claim 1, and thus are patentable over Lin for at least the same reason as claim 1.

Claims 1-2, 14-15 and 18-19 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,076,282 to Brue'. As discussed above, independent claim 1 calls for " a sole of a shoe comprising: a midsole having at least one protrusion disposed in a forefoot

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region thereof; and a plate having at least one receptacle disposed therein, said plate placed adjacent to said midsole such that said receptacle aligns with said protrusion, wherein *a diameter of said receptacle is not greater than a diameter of said protrusion.*"

The Examiner argues that Brue' teaches "a midsole S having at least one protrusion 1, 1a disposed in a forefoot region; [and] a plate P having at least one receptacle 2 disposed therein." (Office Action at page 2.) Unlike the claimed invention that calls for a diameter of the receptacle that *is not greater than* the diameter of the protrusion, the diameter of holes 2 *is greater than* the diameter of protuberance 1a. In fact, the specification of Brue' states that the small cylinder-conical protuberance 1a has "a maximum diameter slightly less than the diameter of the holes 2." Col. 4, lines 33-35.

Additionally, independent claim 18 recites the step of "deflecting at least a portion of said protrusion into said receptacle." At paragraph [0028] of the specification for the present application states that

as protrusion 522 has a similar or slightly larger diameter than receptacle 318, protrusion 522 *is prevented from extending entirely through receptacle 318.* The interaction of protrusions 522 with dispersion plate 208 and receptacles 318 produces a trampoline-like effect. This trampoline-effect is caused by the pressure of the foot on the midsole forcing protrusions 522 downward against dispersion plate 208 as well as pressure from the ground forcing dispersion plate 208 upwards against protrusions 522. *As protrusions 522 are made of a somewhat flexible material, protrusions 522 bow into receptacles 318,* thereby allowing for a small degree of vertical motion only in the vicinity of protrusions 522 with every step.

Thus, the deflection is a bowing of the protrusion as distinguished from extending entirely through the receptacle.

Unlike the deflection step in the claimed method, protuberance 1a of Brue' extends fully into receptacle. In fact the Brue' specification states that "during the pressing action of the foot this protuberance 1a gradually 'occupies' the empty space of the holes 2." Col. 4,

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lines 36-38. Thus, Brue' does not teach the protrusions 1a deflecting into the holes 2 as claimed, and claim 18 is patentable over Brue'. Claim 19 depends from and adds further features to claim 18. Thus, claim 19 is patentable for at least the same reasons as claim 18.

New claim 22 includes the features of claim 1, and also recites "an outsole, wherein said outsole is disposed on an exterior surface of said shoe sole and wherein said plate is disposed between said midsole and said outsole." Thus, claim 22 is patentable for the same reasons noted above with respect to claim 1. Further, neither Lin nor Brue' teach the arrangement of parts as claimed.

In light of these remarks, Applicant respectfully requests the withdrawal of these 35 U.S.C. § 102(b) rejections.

Rejections under 35 U.S.C. § 103

Claims 8-10 and 20 are rejected over 35 U.S.C. § 103(a) as being obvious over either Lin or Brue' in view of U.S. Patent No. 6,199,304 to Ludemann. Claims 8-10 depend from and add further features to claim 1, and thus are patentable for at least the same reasons as claim 1 discussed above. Similarly, claim 20 depends from and adds further features to claim 18, and thus is patentable for at least the same reasons as claim 18 discussed above.

In light of these remarks, Applicant respectfully requests the withdrawal of this 35 U.S.C. § 103(a) rejection.

Other Matters

The Examiner has indicated that claims 3-6 and 21 include allowable subject matter. Applicant submits that independent claims 1 and 18 are also allowable. Claims 3-6 depend from and add features to claim 1, and thus are allowable for at least the same reasons as claim

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1 discussed above. Similarly, claim 21 depends from and adds further features to claim 18, and thus is patentable for at least the same reasons as claim 18 discussed above.

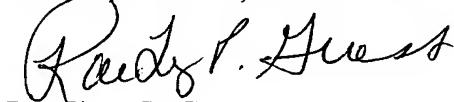
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action, and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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